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10/538,750	03/24/2006	Junji Tan	1155-0302PUS1	5090
2292 7590 11/03/2010 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747				
EXAMINER DOLLINGER, MICHAEL M				
ART UNIT		PAPER NUMBER		
1766				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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mailroom@bskb.com

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 10/18/2010 have been fully considered but they are not persuasive.
2. Applicants argue that the claimed glass transition temperature of 25 to 90°C of copolyester (A) is not disclosed. There were two rationales for an implicit disclosure of the claimed glass transition temperature: 1) the disclosed polymer is crystalline and henceforth has a glass transition temperature above 25°C and 2) the disclosed polymer has an extension temperature that is between the glass transition temperature and 60°C above the glass transition temperature (preferably from between the glass transition temperature and 40°C above the glass transition temperature) and since the exemplified extension temperature is 65°C then the exemplified glass transition temperature is 5°C to 65°C (or 25°C to 65°C). Applicants argue that 1) a crystalline polymer does not necessarily have a glass transition temperature above 25°C and 2) the calculated glass transition temperature is simply a "suggestion" of a glass transition temperature. Regarding rationale 1), applicants' arguments are convincing and the rationale is withdrawn. Regarding rationale 2), these arguments are not convincing. A reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art, including nonpreferred embodiments, see *Merck & Co. v. Biocraft Laboratories*, 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir.), cert. denied, 493 U.S. 975 (1989). Disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or nonpreferred embodiments, see *In re Susi*, 440 F.2d

442, 169 USPQ 423 (CCPA 1971). Whether one calls the glass transition temperature an "implicit" disclosure or a "suggestion", it is still disclosed in the prior art.

3. Applicants also argue that the examples of Sakurai disclose different polymers from those in the claims. This argument is not convincing. Applicants' arguments amount to a contention that the claimed element is a nonpreferred embodiment of the prior art. A reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill the art, including nonpreferred embodiments, see *Merck & Co. v. Biocraft Laboratories*, 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir.), cert. denied, 493 U.S. 975 (1989). Disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or nonpreferred embodiments, see *In re Susi*, 440 F.2d 442, 169 USPQ 423 (CCPA 1971).

4. Applicants also argue that Sakurai does not teach the concept of melt mixing a glycolic acid copolymer and a crystalline polyester to obtain a polyester resin composition having a specific S_{AA}/S_{BB} ratio. This argument is not convincing. Barbee in view of Sakurai teach the same components combined and processed by the same methods as the claimed components. Whether the prior art *intends, understands or describes* the invention in the same way is irrelevant.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MIKE DOLLINGER whose telephone number is (571)270-5464. The examiner can normally be reached on M-F 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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/mmd/

/RANDY GULAKOWSKI/
Supervisory Patent Examiner, Art Unit 1766